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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,135	07/13/2004	Fabio Giannessi	4865-13	7877
23117	7590	05/28/2008	EXAMINER	
NIXON & VANDERHYE, PC			YOUNG, SHAWQUIA	
901 NORTH GLEBE ROAD, 11TH FLOOR				
ARLINGTON, VA 22203			ART UNIT	PAPER NUMBER
			1626	
			MAIL DATE	DELIVERY MODE
			05/28/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/501,135	GIANNESI ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	SHAWQUIA YOUNG	1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 07 February 2008.
- 2a) This action is **FINAL**.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-5, 7 and 9-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 1-5, 7, 11 and 12 is/are allowed.
- 6) Claim(s) 9 and 10 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ .  | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

Claims 1-5, 7 and 9-12 are currently pending in the instant application.

### **I. *Response to Arguments***

Applicants' amendment, filed on February 7, 2008, has overcome the objection of claims 1-5,7,11 and 12 as containing non-elected subject matter. The above objection has been withdrawn. The Examiner has rejoined the method claims 9 and 10 for examination.

However, upon further examination of the current amendments to the claims, a new ground(s) of rejection is made in view of claims 9 and 10 under 35 USC 112, first paragraph for scope of enablement.

### **II. *Rejection(s)***

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8 and 9 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method for the treatment of type 2 diabetes and Syndrome X does not reasonably provide enablement for a method for the treatment of the complications of diabetes, type 1 diabetes and the various forms of insulin

resistance and hyperlipidaemias. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

As stated in the MPEP 2164.01 (a), "There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue."

In *In re Wands*, 8 USPQ2d 1400 (1988), factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. 112, first paragraph, have need described. They are:

1. the nature of the invention,
2. the state of the prior art,
3. the predictability or lack thereof in the art,
4. the amount of direction or guidance present,
5. the presence or absence of working examples,
6. the breadth of the claims,
7. the quantity of experimentation needed, and
8. the level of the skill in the art.

In the instant case

***The nature of the invention***

The nature of the invention is a method for the treatment of type 2 diabetes and Syndrome X.

***The state of the prior art and the predictability or lack thereof in the art***

The state of the prior art is that the pharmacological art involves screening *in vitro* and *in vivo* to determine which compounds exhibit the desired pharmacological activities (i.e. what compounds can treat which specific disease by what mechanism).

There is no absolute predictability even in view of the seemingly high level of skill in the art. The existence of these obstacles establishes that the contemporary knowledge in the art would prevent one of ordinary skill in the art from accepting any therapeutic regimen on its face.

The instant claimed invention is highly unpredictable as discussed below:

It is noted that the pharmaceutical art is unpredictable, requiring each embodiment to be individually assessed for physiological activity. *In re Fisher*, 427 F. 2d 833, 166 USPQ 18 (CCPA 1970) indicates that the more unpredictable an area is the more specific enablement is necessary in order to satisfy the statute. In the instant case, the instant claimed invention is highly unpredictable since one skilled in the art would recognize that in regards to therapeutic effects of type 1 diabetes, the complications of diabetes, and various forms of insulin resistance and hyperlipidaemias whether or not the condition is effected by the activity of the instant compounds would make a difference.

Applicants are claiming a method for the treatment for type 1 diabetes, the complications of diabetes, the various forms of insulin resistance and hyperlipidaemias.

For example, Applicants' claims are therefore drawn to a method for the treatment for type 1 diabetes and the complications of diabetes.

Diabetes, also known as diabetes mellitus, is defined as impaired insulin secretion and variable degrees of peripheral insulin resistance leading to hyperglycemia. Early symptoms are related to hyperglycemia and include polydipsia, polyphagia and polyuria. Later complications include vascular disease, peripheral

neuropathy and predisposition to infection. There are two main categories of diabetes mellitus-type 1 and type 2. Treatment involves control of hyperglycemia to improve symptoms and prevent complications while minimizing hypoglycemic episodes. Oral antihyperglycemic drugs are the primary treatment for type 2 diabetes mellitus. However, there are no treatments that definitely prevent the onset or progression of type 1 diabetes mellitus. All type 1 diabetics require insulin. The complications of diabetes develop through various mechanisms such as glycosylation of serum and tissue proteins with formation of advanced glycation end products; superoxide production; activation of protein kinase C; accelerated hexosamine biosynthetic and polyol pathways, etc. There is not one pathway that all complications of diabetes develop and thus one class compounds could not treat all complications of diabetes.

<http://www.merck.com/mmpe/print/sec12/ch158/ch158b.html>

***The amount of direction or guidance present and the presence or absence of working examples***

The only direction or guidance present in the instant specification is minimal. The specification does not give any guidance of the various forms of insulin resistance and hyperlipidaemias embraced by claim 9. There are no working examples present for the treatment of specific diseases or conditions.

Test assays and procedure are provided in the specification at pages 81-88 such as determination of glucose consumption in 3T3-L1 cells and Antidiabetic and serum lipid lowering activity in db/db mice; . Receptor activity is generally unpredictable and

the data provided is insufficient for one of ordinary skill in the art in order to extrapolate to the other compounds of the claims. It is inconceivable as to how the claimed compounds can treat the extremely difficult diseases embraced by the instant claims.

Applicants have not provided any competent evidence or disclosed tests that are highly predictive for the pharmaceutical use of the instant compounds. Pharmacological activity in general is a very unpredictable area. Note that in cases involving physiological activity such as the instant case, "the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved." See *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

***The breadth of the claims***

The breadth of the claims is a method of treatment for diabetes and its complications, Syndrome X, the various forms of insulin resistance and hyperlipidaemias.

***The quantity of experimentation needed and the level of the skill in the art***

The quantity of experimentation needed is undue experimentation. One of skill in the art would need to determine what diseases would be benefited by the effects of serum glucose and/or serum lipid lowering activity and would furthermore then have to determine which of the claimed compounds in the instant invention would provide treatment of the diseases.

The level of skill in the art is high. However, due to the unpredictability in the pharmaceutical art, it is noted that each embodiment of the invention is required to be

individually assessed for physiological activity by *in vitro* or *in vivo* screening to determine which compounds exhibit the desired pharmacological activity and which diseases would benefit from this activity.

Genentech Inc. v. Novo Nordisk A/S (CA FC) 42 USPQ2d 1001, states that “a patent is not a hunting license. It is not a reward for search, but compensation for its successful conclusion” and “patent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable”.

Therefore, in view of the Wands factors and In re Fisher (CCPA 1970) discussed above, to practice the claimed invention herein, a person of skill in the art would have to engage in undue experimentation to test which diseases can be treated by the compound encompassed in the instant claims, with no assurance of success.

This rejection can be overcome, for example, by amending claim 9 to read on a method for the treatment of type 2 diabetes and Syndrome X.

### III. Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawquia Young whose telephone number is 571-272-9043. The examiner can normally be reached on 7:00 AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/Shawquia Young/

Examiner, Art Unit 1626

/Kamal A Saeed, Ph.D./

Primary Examiner, Art Unit 1626